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Paper No. 10  
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re COFCO Credit Company, L.L.C.

Serial No. 76/029,005

Thomas D. McBain of Gallagher & Kennedy, P.A. for COFCO  
Credit Company, L.L.C.

Fred Mandir, Trademark Examining Attorney, Law Office 105  
(Thomas G. Howell, Managing Attorney).

Before Simms, Cissel and Hohein, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 18, 2000, applicant filed the above-  
referenced application to register the mark "ROAD SEA AIR"  
on the Principal Register for "financial services, namely,  
financing of used motor vehicles, watercraft, aircraft,  
construction and other heavy equipment, and related goods  
purchased via global computer networks," in Class 36; and  
"computer services, namely, providing a web site for an on-  
line auction service for selling or reselling used motor

vehicles, watercraft, aircraft, construction and other heavy equipment, and related goods via global computer networks," in Class 42. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these services.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark is merely descriptive of the services with which applicant intends to use it. The Examining Attorney also required applicant to amend the recitation of services and their classification.

Submitted in support of the refusal to register were copies of a third-party trademark application and a third-party trademark registration. The Examining Attorney argued that the application and the registration demonstrate the descriptiveness of the proposed mark in the case at hand because they show similar terms either disclaimed or used to describe arguably similar services. The application is for the mark "BY LAND SEA AIR" for "providing a web site featuring online cargo rate auctions/negotiations, and published rate and discount information for land, sea and air cargo bearing vessels to allow customers the opportunity to evaluate competitive

prices.”<sup>1</sup> The registration is for the mark “AIR SEA BROKER” and design for freight forwarding and transportation of goods.<sup>2</sup> The registrant disclaimed the words “AIR,” “SEA” and “BROKER.”

Applicant responded by amending the Class 42 services to read as follows: “computer services, namely, providing an on-line auction web site featuring used motor vehicles, watercraft, aircraft, construction and other heavy equipment, and related goods via global computer networks,” in Class 35. Applicant also argued against the refusal to register based on descriptiveness, claiming that its mark is at most only suggestive and that the Examining Attorney had failed to make out a prima facie case of descriptiveness.

The Examining Attorney accepted applicant’s amendment, but was not persuaded by applicant’s arguments with respect to the descriptiveness of the mark. The second Office Action made final the refusal to register under Section 2(e)(1) of the Act. The Examining Attorney held that the words sought to be registered are merely descriptive of applicant’s services because they describe the type of

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<sup>1</sup> S.N. 75/869,670 filed on Dec. 13, 1999 by Planet Traders, Inc.

<sup>2</sup> Reg. No. 2,178,082, issued on the Principal Register on August 4, 1998 to Panalpina Welttransport (Holding) AG Corporation.

vehicles auctioned and financed by applicant.

Attached in support of the final refusal to register were copies of a number of third-party registrations. One lists the goods with which that particular mark is used as "computer hardware and software for use in land, sea and air vehicles." Another lists the services with which the mark therein is used as "entertainment services, namely, ongoing cable television programs featuring historical events and historical stories involving land, air and sea vehicles." Five other third-party registrations use similar wording to describe the goods and services for which the marks are registered.

Applicant timely filed a Notice of Appeal, followed by applicant's brief on appeal. The Examining Attorney also filed an appeal brief, and applicant filed a reply thereto. Applicant did not, however, request an oral hearing before the Board.

The test for determining whether a term or phrase is merely descriptive within the meaning of Section 2(e)(1) of the Lanham Act is whether it immediately and forthwith conveys information concerning a quality, characteristic, function, attribute or feature of the goods or services in connection with which it is used or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ

215 (CCPA 1978); *In re Venture Associates*, 226 USPQ 285 (TTAB 1985); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). A term or phrase does not have to describe every quality, feature, function, etc. of the goods or services in order to be found merely descriptive; it is sufficient instead if it describes a single significant quality, feature or function thereof. Further, it is well-established that the determination of mere descriptiveness of a particular term or phrase must be made not in the abstract or on the basis of guesswork, but instead, in relation to the goods or services for which registration is sought, the context in which the term or phrase is used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). The question is not whether someone presented with only the mark could correctly speculate or guess what the goods or services are; rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB

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1990); and In re American Greetings Corp., 226 USPQ 365 (TTAB 1985).

On the other hand, a mark is suggestive, rather than merely descriptive, if, when the goods are encountered under the mark, a multi-stage reasoning process, or the use of imagination, thought or perception is required in order to determine what attributes of the goods the mark indicates. In re Mayer-Beaton Corp., 223 USPQ 1347 (TTAB 1984). As the Board has stated previously, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1982); and In re TMS Corp. of the Americas, 200 USPQ 57 (TTAB 1978).

Another significant legal principal relevant to the case at hand is that the Examining Attorney bears the burden of establishing that a mark is unregistrable because it is merely descriptive of the goods or services within the meaning of Section 2(e)(1) of the Act. In re Gyulay, supra. Any doubts as to whether a mark is merely descriptive must be resolved in favor of the applicant. In re Aid Laboratories, Inc., 221 USPQ 215 (TTAB 1983).

Simply put, the Examining Attorney contends that "ROAD SEA AIR" is merely descriptive of the sales and financing services set forth in the amended application because these words immediately and forthwith describe the vehicles which applicant auctions and finances. Applicant's argument can be similarly boiled down to the contention that the proposed mark does not fall within the proscription of Section 2(e)(1) of the Act because it is only suggestive of applicant's services, and only through the exercise of mental gymnastics and extrapolation can the mark be understood to suggest or hint at the nature of applicant's services. While applicant admits that its services are essentially "selling and financing cars, boats, airplanes, heavy equipment motorcycles, etc." (brief, p. 2), applicant argues that the purchasers of such products do not commonly refer to them as "road," "sea" or "air" vehicles. Applicant contends that naming the media in or on which the vehicles it sells and finances move "is two steps removed from the services" (brief p. 3), and that this is not nearly a direct enough description of its services themselves to support the refusal to register.

We agree with applicant. The connection between "ROAD SEA AIR" and applicant's auction and financing services is too indirect to support the conclusion that the mark

immediately and forthwith conveys information about the nature of the services.

The third-party trademark application submitted by the Examining Attorney evidences nothing other than that the application was filed, but the registrations submitted by the Examining Attorney do refer to vehicles as "land, sea and air vehicles." (Interestingly, neither applicant nor the Examining Attorney is apparently concerned that the word "ROAD" is not mentioned in any of them.) Such uses of "LAND," "SEA" and "AIR" in trademark registrations, however, are not necessarily indicative of the ways these terms (and certainly not the word "ROAD") are used in the relevant auction and financing markets, or, for that matter, by the public in general. As noted above, the goods and services in these registrations include computer hardware and software, and entertainment services such as television programs, while others set forth solid-state digital remote power controllers, hobby kits and so forth, but not one of these registrations demonstrates use of the words "ROAD," "SEA" or "AIR" to describe services like the ones specified in the instant application.

We conclude that a multi-stage reasoning process, or the use of some imagination, thought or perception, is required in order to determine the characteristics of the

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services to which the mark refers. We readily admit that our determination here involves subjective judgment, but we are left to adhere to the rule that any doubt on this issue must be resolved in favor of the applicant.

DECISION: The refusal to register under Section 2(e)(1) of the Act is reversed.